

Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed November 29, 2005.

Claims 1-12 and 33-50 were pending in the Application prior to the November 29, 2005 Office Action. Of the above claims, 33-46 are withdrawn from consideration. In the November 29, 2005 Office Action, the Examiner rejected Claims 1-12 and 47-50. In the present reply, the Applicant amends Claims 47 and 49. The amendments introduced into Claims 47 and 49 are supported in the specification at least at paragraph [0047]. The Applicant respectfully requests that the Examiner reconsider the rejection, since it is the Applicants belief that Claims 1-12 and 47-50 are now in condition for allowance.

Claim Rejections Under 35 U.S.C. § 102

Within the Office Action, Claims 1-12 and 47-50 were rejected under 35 U.S.C. 102(e) as being anticipated by PG-PUB 2005/0113842 to Bertagnoli et al. (hereinafter "*Bertagnoli*"). The Examiner's position is that Bertagnoli discloses a tool to distract the upper and lower vertebral bodies having a first cutting blade adapted to cut a groove in the upper vertebral body; and a second cutting blade protruding downwardly from the cutter body and adapted to cut a groove in the lower vertebral body, wherein the first and second cutting blades are parallel to one another; wherein the second cutting blade is spaced from the first cutting blade by the thickness dimension of the cutter body.

Claim 1

Bertagnoli does not disclose the Applicant's tool. Specifically, the Applicant's tool:

- is forked to cut around the cauda equina, *Bertagnoli* does not disclose a forked tool.
- has an inner and outer tine on each of the forked ends *Bertagnoli* does not disclose the relative positions of (upper and lower) chisels.
- has two inner tines and two outer tines, *Bertagnoli* does not disclose multiple (upper or lower) chisels.
- is designed to position two grooves into the upper vertebral body at the same time as it positions two grooves into the lower vertebral body so that they do not damage the cauda equina as shown in Fig.

5A. *Bertagnoli* does not disclose a means to avoid damaging the cauda equina; to cut multiple grooves in the upper or lower vertebral bodies; or a means to produce grooves that are parallel to the other grooves.

When making the grooves with the Applicant's tool and subsequently inserting an implant, the Applicant makes one pass with the tool. This results in savings in the time of the surgeon and anaesthetist for making/supervising an operation involving a single cut. Further, the Applicants tool requires no surgical compensation for the effect of two or more separate passes which would be required with the chisel of *Bertagnoli*. For example with the Applicant's tool, all the grooves are parallel, so that the implants are inserted on one plane.

Claim 2

Claim 2 recites two limitations "the first and the second cutting blades are parallel to each other and over the entire length of the blade cutting surface" and "the first and second blades are parallel to the handle of the tool" that are not disclosed in *Bertagnoli*. In *Bertagnoli*, the keel blade 420 extends distally from a shaft 415, which includes a handle connector 410 at a proximal end thereof. A guiding fin 425 extends along the bottom of keel blade 420 and is adapted for positioning in keyways 192 and 242 of first and second members 106 and 108" (*Bertagnoli*, paragraph [0081], third & fourth sentences). Thus the keel blades are parallel with the first and second members. However, distance 110 can be increased or decreased by manipulation of handle assemble 102 to provide a desired separation distance between adjacent vertebrae in contact with first and second members 106, 108 (*Bertagnoli*, paragraph [0048], fourth sentence). As 110 is increased the angle between the shaft 120 and 106 or 108 increases. Since 106 and 108 are not parallel, then the keel blades 320 and 420 are not parallel with each other or with the handle. Thus *Bertagnoli* does not disclose the element of Applicant's Claim 2 wherein the first and second cutting blades are parallel to each other over the entire length of the blade cutting surface. Nor does *Bertagnoli* disclose the element of Applicant's Claim 2 wherein the first and second blades are parallel to the handle of the tool. Further, Claim 2 depends from Claim 1 and is believed patentable for at least the same reasons as independent Claim 1 and because of the additional limitations of these claims.

Claims 3-12

Claims 3-12 each depend from currently amended Claim 1 and are believed patentable for at least the same reasons as independent Claim 1 and because of the additional limitations of these claims

Claims 47 and 49

Claims 47 and 49 have been amended so that they specify that the tool has a pair of cutting blades protruding upwardly and a pair of cutting blades protruding downwardly. *Bertagnoli* does not disclose multiple upward directed and multiple downward directed protruding blades. As such, *Bertagnoli* does not disclose the Applicant's tool.

Claim 48

Claim 48 recites that the tool has a forked end and two tines, each tine having an inner and outer side and a cutting blade extending from each side. Thus, there are four cutting edges. *Bertagnoli* does not disclose four cutting blades. As such, *Bertagnoli* does not disclose the Applicant's tool.

Claim 50

Claim 50 recited an embodiment where the upper and lower blades are parallel to one another and parallel to the handle of the tool. *Bertagnoli* does not disclose that the chisel is parallel to the shaft (120) handle. As such, *Bertagnoli* does not disclose the Applicant's tool.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the 102(e) rejection.

CONCLUSION

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: 12/21/05

By: 

Anthony G. Craig
Reg. No. 50,342

FLIESLER MEYER LLP
Four Embarcadero Center, Fourth Floor
San Francisco, California 94111-4156
Telephone: (415) 362-3800
Customer No. 23910
ACraig@fdml.com

BEST AVAILABLE COPY

- 11 -

Attorney Docket No.: KLYCD-05009US1 SRM/AGC
M:\ACraig\wp\KLYCD\5009US1\5009US1.ROA 112905 filed.wpd